

REMARKS

I. Status and Disposition of the Claims

a. General status of the application and claims

Claims 20-76 are pending in this application. No claims are amended herein.

In a Requirement for Election of Species mailed November 2, 2005, the Examiner required election of a single species of latent pigment from those corresponding to the formula $A(B)_x$ for examination. See Requirement for Election of Species mailed November 2, 2005, page 2. In a Response filed March 2, 2006, Applicants elected, with traverse, azo compounds, which read on claims 20-26, 45, and 48-76. See Response filed March 2, 2006, page 2. Applicants continue to argue that the Requirement for Election of Species is improper, at least because the Examiner has failed to establish that examination of all of the alleged species constitutes an undue burden. *Id.* Despite these arguments, the Examiner maintains and makes final the Requirement for Election of Species. Office Action, page 2. Thus, the Examiner has withdrawn claims 27-44, 46 and 47 from consideration. *Id.* Accordingly, Claims 20-26, 45, and 48-76 are pending and under consideration on the merits.

Applicants continue to traverse the Requirement for Election of Species for the reasons of record, which are specifically incorporated herein by reference. Further, Applicants respectfully remind the Examiner of his duty to expand his search to a "reasonable number of species," as provided in M.P.E.P. §808.02 and 35 U.S.C. §121.

b. Indication of allowable subject matter and outstanding rejections

In the present Office Action, the Examiner indicates that claims 20-26, 45, 48-54, and 69-76 are allowable over the prior art of record. See present Office Action, page 4. Further, the Examiner indicates that claims 58, 60-65 and 68 are objected to as being dependant upon a rejected base claim, but as allowable if re-written in independent form. *Id.* at 3. However, the Examiner rejects claims 55-57, 59, 66 and 67 under 35 U.S.C. §102(b) as anticipated by United States Patent No. 6,160,037 to Leugs et al. ("Leugs"). *Id.*

Applicants respectfully acknowledge the Examiner's indication of allowable subject matter. However, Applicants maintain that all of the pending claims are allowable over the prior art of record.

II. Arguments

Claims 55-57, 59, 66 and 67 stand rejected under 35 U.S.C. §102(b) as anticipated by United States Patent No. 6,160,037 to Leugs et al. ("Leugs"). Office Action at 3. According to the Examiner, Leugs "teaches a composition comprising a pigment and alcohols of amino-methyl-propanol and ethylene glycol." *Id.* at 3 (citing column 30, example 11 of Leugs). Further, the Examiner asserts that the pigment disclosed by Leugs, "is identical to the claimed formula (I), when in the reference's formula, (I), A is a dye (chromophoric) radical chosen from azo dye of a formula (XVIIIa, XVIIIb, XVIIIc...)." *Id.* (citing column 2, lines 35-67; column 3, lines 36-50; and columns 13 and 14 of Leugs). From this, the Examiner maintains that Leugs anticipates the claimed invention. *Id.* Applicants respectfully disagree with the Examiner's position for at least the following reasons.

To establish anticipation under 35 U.S.C. §102, the Examiner must show that each and every element as set forth in a claim is described, either expressly or inherently, in a single prior art reference. See M.P.E.P. §2131. Indeed, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *Id.* Moreover, the identical invention must be described in as complete detail as contained in, and must be arranged as required by, the claim at issue. *Id.* In the present Office Action, however, the Examiner has not, and indeed cannot, establish that the claimed invention is identically taught by Leugs, as discussed in detail below.

Claim 55 recites, *inter alia*,

[a] cosmetic composition for dyeing keratin fibers comprising at least one latent pigment...wherein the at least one latent pigment is capable of being chemically, thermally, or photochemically converted in the keratin fibers into an at least one water-insoluble pigment.

Claim 55 (emphasis added). In contrast, Leugs teaches pigment compositions comprising a latent pigment, and reactions wherein a high molecular weight organic material (e.g., biopolymers, plastic materials, glasses, ceramics, inks, lacquers, paints, non-impact printing material, etc.) is pigmented with a latent pigment material. See Leugs, column 1, line 62-column 2, line 35; column 23, lines 5-46; and column 24, lines 40-62. However, Leugs is completely silent with respect to a cosmetic composition for dyeing keratin fibers, much less a method for dyeing keratin fibers wherein a latent pigment is reacted on or within keratin fibers, as claimed.

Based on the Examiner's reasoning in the present Office Action, it is clear that the Examiner is ignoring the preamble of the present claims. Specifically, the Examiner is ignoring the recitation in claim 55 of "[a] cosmetic composition for dyeing keratin

fibers.” Claim 55. However, this interpretation of the claims is inconsistent with both the case law of the Federal Circuit Court of Appeals and the Manual of Patent Examination and Procedure (M.P.E.P.). See *In Re Cruciferous Sprout*, 301 F.3d 1343, 1346-48 (holding that the claim preamble “rich in glucosinolates” helped define the claimed invention as evidenced by the specification and prosecution history). See also M.P.E.P. § 2111.02. Indeed, “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).

In the present application the preamble of claim 55, which states, “[a] **cosmetic composition for dyeing keratin fibers...**” imparts both structural and functional elements to the composition recited later in the claim, and thus breathes life and meaning into the claim. Claim 55 (emphasis added). Indeed, not only does the preamble indicate that the claimed composition must be a cosmetic composition, it also indicates that the composition must be capable of dyeing keratin fibers. *Id.* As stated above, however, Leugs 1 is silent with respect to the capability of the disclosed latent pigment composition to dye keratin fibers. Further, Leugs does not teach or suggest that the disclosed latent pigments are capable of dyeing keratin fibers by conversion within the fiber itself, as claimed.

In addition, the Examiner’s own statement - that the pigment of Leugs is identical to the claimed formula (I), “**when**, in the reference’s formula (I)” A and B are chosen from various components or parameters - undercuts the assertion that Leugs anticipates the claimed invention. Office Action at 3 (emphasis added). If anything, the

Examiner's argument indicates that impermissible "picking and choosing" from the disclosure of Leugs is required to arrive at the presently claimed invention. However, to establish anticipation under 35 U.S.C. §102, the reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound **without any need for picking, choosing, and combining various disclosures**" *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972) (emphasis added).

While Leugs may disclose some latent pigments, Leugs does not teach the claimed dyeing composition for keratin fibers containing certain latent pigments, as recited in claim 55, and certainly does not teach the specific combination of compounds recited in claim 56. Indeed, Leugs is completely silent with respect to specific combination of compounds recited in the present claims.

For at least the foregoing reasons, it is clear the Examiner has not, and indeed cannot, establish that Leugs teaches all of the limitations of pending claims 55-57, 59, 66, 67 and 68. Thus, Applicants submit that the rejection of claims 55-57, 59, 66 and 67 under 35 U.S.C. 102(b) is improper, and should be withdrawn.

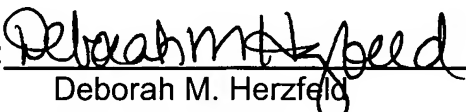
III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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